

Notice of Allowability	Application No.	Applicant(s)	
	10/608,365	SAKAMOTO ET AL.	
	Examiner	Art Unit	
	Marc S. Zimmer	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 06/30/03.
2. ☒ The allowed claim(s) is/are 1-3.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

Allowable Subject Matter

Applicant discloses a composition comprising (i) 100 parts by weight of an alkoxy group-functionalized polysiloxane adhering to one of three basic formulae, (ii) 1 to 30 parts by weight of a hydroxyl group-terminated polydiorganosiloxane, (iii), 0.5 to 15 parts by weight of an alkoxysilane, and (iv) a titanium chelate catalyst. Subsequent claims further limit the base claim by requiring the presence of additional materials.

In their Information Disclosure Statement, Applicant cites Allen et al, U.S. Patent # 4,652,624, which teaches a composition that mirrors the instant invention in numerous respects but is different in one fundamentally important way. That is, whereas component (A) of the present invention is the base polymer and makes up the dominant fraction of the total weight of the composition while the hydroxyl group-terminated polydiorganosiloxane constitutes only between 0.9 to 23 % of the weight of the composition, the hydroxyl group-terminated polydiorganosiloxane makes up the largest fraction by weight of the prior art composition. Applicant has shown in their examples that the relative amounts of these materials is critical to the long-term efficacy of their invention (see the results of Examples 1 and 2 versus Comparative Examples 2 and 3). Further, there is nothing in the art motivating one of ordinary skill to modify the invention of Allen et al. in the manner necessary to arrive at the instant invention.

A composition taught by Angus, U.S. patent # 5,936,032 more closely matches the instant invention than does even that of Allen insofar as 100 parts of the alkoxy-functional polysiloxane is used. However, Angus also discloses the use of 100 parts of the hydroxy-terminated siloxane polymer. Applicant has demonstrated these large

quantities of the hydroxy-terminated siloxane polymer as being detrimental to their invention hence Angus also fails to anticipate or render obvious the claimed invention.

Fulton, U.S. Patent # 3,676,420 discloses yet another similar composition that, like the others, is fundamentally different for the reason that the amounts of the hydroxyl group-terminated polydiorganosiloxane and alkoxy group-functionalized polysiloxane are well outside the recited ranges.

JP 61-021157 A contemplates a system that is also remarkably similar to that of Applicant but is not considered an anticipatory reference for the same reasons the aforementioned documents were considered deficient. This reference is lacking for the additional reason that the precise structure of the alkoxy-functional polysiloxane is not disclosed and the silane corresponding to (iii) of the instant invention is amino-functional. Component (iii), by contrast only contains non-hydrolyzable hydrocarbon substituents (consisting of hydrogen and carbon atoms only).

These references represent, in the Examiner's view, the closest prior art. Inasmuch as they do not even render obvious the instant invention, claims 1-3 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 23, 2004



MARGARET G. MOORE
PRIMARY PATENT EXAMINER
ART UNIT 1712